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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/677,392	09/29/2000	Aditya Mukherjee	042390.P9572	3111

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EXAMINER

CHAUDRY, MUJTABA M

ART UNIT	PAPER NUMBER
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2133

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/677,392

Applicant(s)

MUKHERJEE, ADITYA

Examiner

Mujtaba K Chaudry

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-23 is/are rejected.
- 7) ☒ Claim(s) 2 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Applicant's arguments/amendments with respect to amended claims 1-4, 10, 12, 18 and 20, previously presented claims 5-9, 13-17 and 19, cancelled claim 11 and newly added claims 21-23 filed June 14, 2004 have been fully considered but are not persuasive. The Examiner would like to point out that this action is made final (See MPEP 706.07a).

Response to Arguments

Applicant contends, "...none of the IC tester claims in Wasson (prior art of record) comprise a limitation of a DUT or IC." The Examiner respectfully disagrees. Wasson teaches (col. 3, lines 54-63 and Figure 1) the integrated circuit tester 10 in Figure 1 is all on one single integrated circuit and hence the tester is part of the DUT on the integrated circuit as seen in Figure 1.

Applicant contends, "...Wasson simply does not disclose, teach or suggest an IC comprising test components where the test instructions are generated and executed directly on the IC to tested." The Examiner respectfully disagrees. Wasson teaches (col. 4, lines 55-68 and Figure 2) a tester channel CH(1) that includes an addressable instruction memory 30 for storing a sequence of instructions and a conventional memory controller 32 allowing disk controller 18 of FIG. 1 to write instructions into instruction memory 30 via memory bus 24. To signal the start of a test, host computer 16 pulses the START signal providing an input to a state machine 34. A timing circuit 36 supplies a "period clock" signal (PCLK) as input to state machine 34.

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Timing circuit 36 receives the master clock signal MCLK as timing reference and periodically pulses the PCLK signal to mark the start of each test cycle. Furthermore, the Examiner would like to point out that by rearrange to make integral does not necessarily make the claims non-obvious over the prior art of record. See *In re Larson* 144 USPQ 347 (CCPA 1965) and *IN re Japikse* 86 USPQ 70 (CCPA 1950).

Claim Objections

Claim 2 is objected to because of the following informalities:

- Claim 2 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The limitations of claim 2 do not further limit those of claim 1 because in claim 1 the integrated circuit **comprises** the test controller, which makes it the same as an integrated test controller.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

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3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wasson (USPN 6181151 B1). See office action, paper No. 6

The Examiner disagrees with the Applicant and maintains all rejections with respect to amended claims 1-4, 10, 12, 18 and 20, previously presented claims 5-9, 13-17 and 19, cancelled claim 11 and newly added claims 21-23. All arguments have been considered. It is the Examiner's conclusion that amended claims 1-4, 10, 12, 18 and 20, previously presented claims 5-9, 13-17 and 19, cancelled claim 11 and newly added claims 21-23 are not patentably distinct or non-obvious over the prior art of record.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing

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date of this final action. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiries concerning this communication should be directed to the examiner, Mujtaba Chaudry who may be reached at 571-272-3817. The examiner may normally be reached Mon – Thur 6:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, please contact the examiner's supervisor, Albert DeCady at 571-272-3819.

Any inquiry of general nature or relating to the status of this application or proceeding should be directed to the receptionist at 571-272-3609.



Mujtaba Chaudry
Art Unit 2133
November 3, 2004



GUY J. LAMARRE
PRIMARY EXAMINER